

REMARKS

This amendment is submitted subsequent to a Notice of Appeal that was filed on April 27, 2010, and is filed concurrent with a Request for Continued Examination (RCE).

Procedural Background

A final Office Action issued from the U.S. Patent and Trademark Office on October 27, 2009. In response thereto, applicant filed a Response After Final on January 21, 2010. When no reply to the Response After Final was received, applicant filed the April 27, 2010, Notice of Appeal to maintain the pendency of the present application. The U.S. Patent and Trademark Office thereafter mailed an Advisory Action on May 28, 2010.

The present amendment and RCE is responsive to the above-noted final Office Action and Advisory Action and is understood to place the application in condition for allowance.

Summary of Telephone Interviews

Applicant thanks Examiner Weisberger for the time and consideration he extended in telephone interviews conducted with the undersigned counsel on April 16, 2010, and on June 15, 2010. The telephone interview on April 16, 2010 focused principally on Claims 10, 11, 32, 33, 42, 43, and 52, and the features of the claims that distinguish over PCT/US00/10803 (hereinafter "Korhammer"). Potential amendments to clarify the claims were also discussed, though agreement as to allowability of the claims was not reached.

In the June 15, 2010, telephone interview, the Examiner considered the claims as amended herewith. The Examiner determined that the amended claims define the claimed invention over the cited art, and upon filing, the amended claims would advance prosecution of the present application. Applicant is thus submitting the present amendment for entry into the application file. The application is believed to be in condition for allowance.

Status of the Claims

Claims 10-14, 18-20, 31-36, 38-46, and 48-52 are pending in the present application. The October 27, 2009, final Office Action rejected Claims 10, 11, 32, 33, 42, 43, and 52 under

35 U.S.C. § 103(a) as allegedly being unpatentable over Korhammer (published as WO 00/63814). The final Office Action did not address Claim 35; absent a stated rejection, Claim 35 is presumed to be allowable.¹ Applicant thanks Examiner Weisberger for the indication of allowance of Claims 12-14, 18-20, 31, 34, 36, 38-41, 44-46, and 48-51.

For at least the reasons discussed below, applicant requests reconsideration and allowance of Claims 10, 11, 32, 33, 42, 43, and 52.

Previously Pending Claims 10, 11, 32, 33, 42, 43, and 52 Were Patentable Over Korhammer

Before discussing the presently amended claims, applicant makes clear that the previously-pending Claims 10, 11, 32, 33, 42, 43, and 52 were already patentable over Korhammer. The amendments presented herewith merely clarify the claimed features and further distinguish the claims over the cited art.

In the October 27, 2009, final Office Action, Claims 10, 11, 32, 33, 42, 43, and 52 were rejected as allegedly being unpatentable over Korhammer. The Office Action conceded that Korhammer failed to teach "a plurality of sets of conditional rules defined in a memory therein, each set of conditional rules defining a discovery strategy and an action strategy, the discovery strategy specifying parameters for whether and how to obtain price quotations for at least one of a plurality of markets, and the action strategy specifying order processing parameters," as previously recited in Claim 32. Similar features were recited in Claims 10, 42, and 52.

To overcome the teachings that were missing from Korhammer, the Office Action appeared to rely on alleged knowledge in the art, arguing "it would have been obvious for one skilled in the art to have added a feature to discover the lowest price (the discovery strategy) and

¹ The Advisory Action mailed May 28, 2010, included a note stating that "claim 25 was inadvertently omitted from the rejected claims but is included in the merits of the rejection and thus the rejected claims should read 1 [sic - 10], 11, 32, 33, 42, 43 and 52." However, Claim 25 was previously canceled. It is possible the Examiner meant to refer to Claim 35. However, it is still unclear whether Claim 35 has been allowed or rejected. Claim 35 was not included in the merits of the rejection in the October 27, 2009, Office Action. Applicant submits that Claim 35 is allowable, both for its dependence on allowable Claim 32 and for the additional subject matter it recites.

to have executed the trade (the action strategy) as motivated by the need to either comply with regulations or to find their clients the lowest price." (See final Office Action, page 2).

As indicated in applicant's Response After Final submitted January 21, 2010, the claim rejections set forth in the Office Action were not commensurate with the scope of the claims. Furthermore, the claim rejections lacked evidentiary support. To the extent the Examiner intended to take Official Notice, such notice was traversed. At a minimum, such Official Notice was not made in compliance with the Office's own procedures as set out in M.P.E.P. § 2144.03.

Prior to amendment, Claims 10 and 32 each recited "a plurality of sets of conditional rules defined in a memory therein," while Claim 42 recited "a trader-selected set of conditional rules." Claim 52 recited "a trader-selection of a set of conditional rules from a plurality of sets of conditional rules defined in a memory." As further explained in applicant's January 21, 2010, Response After Final, none of the above claim elements were rendered obvious by the alleged knowledge in the art "to discover the lowest price" and "to have executed the trade."

The feature "to discover the lowest price," as alleged in the Office Action, indicated nothing that suggests "a plurality of sets of conditional rules . . . , each set of conditional rules defining a discovery strategy and an action strategy, the discovery strategy specifying parameters for whether and how to obtain price quotations for at least one of a plurality of markets," as previously claimed in Claim 32. Market participants may be inclined to seek out the lowest price (at least for buying), but such interest does not constitute a discovery strategy that "specif[ies] parameters for whether and how to obtain price quotations for at least one of a plurality of markets."

Similarly, the feature "to have executed the trade," as alleged in the Office Action, does not suggest "a plurality of sets of conditional rules . . . each set of conditional rules defining . . . an action strategy, . . . the action strategy specifying order processing parameters," as claimed. Indeed, the Office Action did not cite any prior art or other evidence that a "plurality of sets of

conditional rules" or even a "set of conditional rules," as recited in the claims in combination with other claimed features, were known in the art at the time the present application was filed.

Additionally, it was pointed out that Korhammer provides no teaching or suggestion of an "order-handling program *configured with the selected set of conditional rules* to route the order to at least one of the plurality of markets *in accordance with the set of conditional rules*," as previously recited in Claim 32.

While Korhammer purports to describe a user selecting a particular market for routing an order (for example, NASDAQ SelecNet, an ECN, or the CCS order book "ColorBook" as shown at 704-706 in Figure 9), user designation of a market for routing does not describe or suggest execution of an order-handling program that includes automatically routing an order to at least one of a plurality of markets in accordance with the selected set of conditional rules. There are no "conditions" to consider in Korhammer as the user has expressly designated the market for routing the order.

Similar arguments applied to independent Claims 32, 42, and 52, prior to amendment.

Notably, the above-mentioned Advisory Action did not address these arguments other than to allege that applicant's arguments "fail to consider the broadest reasonable interpretation of the claims and the limitations therein."

Current Claims 10, 11, 32, 33, 42, 43, and 52 Are Patentable Over Korhammer

While applicant submits that the previously-pending claims were in condition for allowance, applicant desires to advance the prosecution of the present application. Applicant has therefore amended Claims 10, 32, 42, and 52, as indicated above, to clarify the distinguishing features of the claims. In view of the telephone interview with the Examiner on June 15, 2010, it is applicant's understanding that the amended claims are patentable over Korhammer, and that Claims 10, 32, 42, and 52 are in allowable condition.

According to amended Claim 10, a plurality of sets of conditional rules are stored in a memory. Each set of conditional rules defines a discovery strategy and an action strategy. The

discovery strategy specifies parameters for computer-implemented logic that determines whether to obtain a price quotation for at least one of a plurality of markets and indicates at least one procedure for obtaining the price quotation. The action strategy specifies order processing parameters.

Further, according to Claim 10, each set of conditional rules is implemented in a computer-executable order-handling program. Execution of the order-handling program includes automatically routing an order to at least one of a plurality of markets in accordance with the selected set of conditional rules.

A trader selection of a set of conditional rules is received. Also received is an order for processing in accordance with the selected set of conditional rules, and information is applied to the selected set of conditional rules to determine at least one of the plurality of markets to which to route the order.

Lastly, the order-handling program is executed, configured with the selected set of conditional rules, to route the order to the at least one of the plurality of markets in accordance with the set of conditional rules.

The foregoing features are neither taught nor suggested by Korhammer. As noted above, according to Korhammer, a user selects a particular market for routing an order (for example, a user may select NASDAQ SelecNet, an ECN, or the CCS order book "ColorBook" as shown at 704-706 in Figure 9). Having a user select a market for routing neither teaches nor suggests a method in which an order-handling program is executed, which includes automatically routing an order to at least one of a plurality of markets in accordance with a selected set of conditional rules. There are no "conditions" to consider in Korhammer as the user has expressly designated the market for routing the order. Korhammer also fails to teach or suggest a plurality of sets of conditional rules that are stored in a memory, where each set defines a discovery strategy (which, according to Claim 10, specifies "parameters for computer-implemented logic that determines whether to obtain a price quotation for at least one of a plurality of markets") and an action

strategy (which "indicates at least one procedure for obtaining the price quotation"). For at least these reasons, amended Claim 10 is patentable over Korhammer.

Similar arguments apply to amended Claims 32, 42, and 52, which recite similar elements albeit in slightly different terms.

Furthermore, Claims 11-14, 18-20, and 31 each directly or indirectly depend from Claim 10, while Claims 33-36 and 38-41 each directly or indirectly depend from Claim 32, and Claims 43-46 and 48-51 each directly or indirectly depend from Claim 42. Applicant respectfully submits that these claims are in condition for allowance for at least the same reasons presented above. Claims 11-14, 18-20, 31, 33-36, 38-41, 43-46, and 48-51 are also patentable for the additional subject matter they recite. As previously noted, the final Office Action already acknowledged the allowability of Claims 12-14, 18-20, 31, 34, 36, 38-41, 44-46, and 48-51.

Information Disclosure Statements

For completion of the file, applicant requests that the Examiner initial and return a copy of the Information Disclosure Statements submitted September 14, 2001; October 13, 2006; December 21, 2006; September 20, 2007; October 9, 2007; January 4, 2008; and October 24, 2008.

Applicant also requests reconsideration of the Information Disclosure Statement submitted September 18, 2009. A signed copy of the September 18, 2009, IDS was included with the October 28, 2009, final Office Action, but none of the references listed in the IDS were initialed by the Examiner and nor did any of the pages of the IDS bear the text "All References Considered Except Where Lined Through. /R.W./" as the Examiner has used with other Information Disclosure Statements. Applicant seeks confirmation in the record that the cited references were considered.

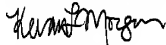
CONCLUSION

Applicant respectfully submits that the claims in the present application are in condition for allowance. Reconsideration and allowance of the application at an early date is requested.

Should any issues remain, the Examiner is invited to contact the undersigned counsel by telephone at the number indicated below.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Kevan L. Morgan".

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